

REMARKS

Claim 3 has been amended to include the solvents recited in claim 15 other than alcohols and ethyl acetate, and claim 15 has been canceled. In this regard, Applicants direct the Examiner's attention to MPEP 2173(i), which states that if alternative elements are positively recited in the specification, they may be explicitly excluded in the claims (see *In re Johnson*, 558 F.2d 1008, 1019, 294 USPQ 187, 196 (CCPA 1977)); since alcohols are positively recited at page 16, line 14 as one alternative which can be used for the other solvents other than aprotic solvents, they can be explicitly excluded in the claims, and since ethyl acetate is positively recited at page 16, line 37 as one alternative which can be used for the other solvents other than aprotic solvents, it can be explicitly excluded in the claims. Claim 12 has been amended to delete "-type" to resolve an issue raised by the Examiner under 35 U.S.C. § 112. Claim 13 has been amended based on, e.g., Examples such as Example 9 (which has 20 percent mass of at least one type of aromatic hydrocarbon having 9 carbon atoms or more within the molecule) and Example 14 (which has 10 percent mass of at least one type of aromatic hydrocarbon having 9 carbon atoms or more within the molecule). Claim 17 has been added corresponding to claim 13 except for reciting "consists essentially of" language, and that the remover consists essentially of solvents. Claim 18 has been added to rewrite former claim 3 as a method of use claim. Claim 19 has been added to rewrite former claim 13 as a method of use claim.

Entry of the above amendment is respectfully requested.

Rejection under 35 U.S.C. § 112, Second Paragraph

On page 2 of the Office Action, in paragraph 5, claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

The Examiner's position is basically that the limitation "acrylic-type photosensitive composition" in claim 12 is not clear because the addition of the word "type" to an otherwise definite expression extends the scope of the expression so as to render it indefinite.

In response, Applicants have amended claim 12 to delete "-type" to resolve this issue. Accordingly, Applicants submit that amended claim 12 satisfies the requirements of 35 U.S.C. § 112, second paragraph, and withdrawal of this rejection is respectfully requested.

Anticipation Rejection over Takagi

On page 3 of the Office Action, in paragraph 7, claims 3, 12 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Takagi et al. (US Patent 5,521,054).

In response, Applicants have amended independent claim 3 to distinguish the present invention from Takagi et al. In particular, Applicants have amended claim 3 by combining it with claim 15 of the present application, except that alcohols are deleted from the group of the other solvent other than aprotic polar solvents recited in claim 15 and ethyl acetate is excluded from the carboxylic acid esters. Thus, claim 3 requires that the other solvent other than aprotic polar solvents is at least one selected from the group consisting of glycol ethers, glycol ether carboxylates, carboxylic acid esters excluding ethyl acetate, hydroxycarboxylic acid esters, ketones, alkoxycarboxylic acids esters, and cyclic ethers.

Applicants submit that amended claim 3 is different from Takagi et al., since Takagi et al. contain three components, i.e., (A) at least one aromatic hydrocarbon having a boiling point of from 150° to 300° C, (B) at least one alcohol represented by the specific formula, and (C) isobutyl isobutyrate, as essential components, but does not also teach using at least one solvent selected from the group consisting of glycol ethers, glycol ether carboxylates, carboxylic acid esters excluding ethyl acetate, hydroxycarboxylic acid esters, ketones, alkoxycarboxylic acids esters, and cyclic ethers.

Thus, Applicants submit that the present invention is not anticipated by Takagi et al., and withdrawal of this rejection is respectfully requested.

Anticipation Rejection over Kasari et al.

On page 4 of the Office Action, in paragraph 8, claims 3, 12 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kasari et al. (US Patent 5,330,796) and as evidenced by Takagi et al. (US Patent 5,578,420).

In response, Applicants note that Kasari et al. relates to a method of forming a coating film excellent in finished appearance. As indicated by the Examiner, Kasari et al. disclose use of a mixed solvent composed of 20 percent by weight of Swazol #1000, which corresponds to the "basically C₉ or C₁₀-based aromatic hydrocarbon(s) having 9 carbon atoms or more within the molecule" in the present invention, and 80 percent by weight of ethyl acetate for preparing a base coat composition (column 16, lines 3-4).

However, as discussed above, claim 3 has been amended to require that the other solvent other than aprotic polar solvents is at least one selected from the group consisting of glycol

ethers, glycol ether carboxylates, carboxylic acid esters excluding ethyl acetate, hydroxycarboxylic acid esters, ketones, alkoxycarboxylic acids esters, and cyclic ethers. Applicants submit that amended claim 3 is different from Kasari et al., since Kasari et al. does not teach using at least one solvent selected from the group consisting of glycol ethers, glycol ether carboxylates, carboxylic acid esters excluding ethyl acetate, hydroxycarboxylic acid esters, ketones, alkoxycarboxylic acids esters, and cyclic ethers. Thus, Applicants submit that the present invention is not anticipated by Kasari et al.

Further, the mixed solvent in Kasari was added only in order to adjust the viscosity of a coating composition having a flaky metal powder and/or a mica powder (column 16, lines 4-5). The base coat composition was prepared by use of a mixture of the resin solution (a) obtained beforehand and the resin solution (b-1) obtained beforehand (column 15, lines 64 to column 16, line 5), and these resin solutions contained xylene as a solvent (column 14, lines 39; and column 15, lines 3-4). Therefore, when the above-mentioned mixed solvent was added to the mixture of the resin solutions (a-1) and (b-1), the solvent in the obtained mixture contained Swazol #1000, ethyl acetate and xylene, which is different in composition from claim 3 of the present application. (Kasari et al. do not suggest that a mixed solvent consisting only of Swazol #1000 and ethyl acetate can be a solvent for a photosensitive composition.)

Therefore, Applicants do not believe the present invention would be anticipated by Kasari et al., which only discloses a mixed solvent composed of Swazol #1000 and ethyl acetate only as a viscosity adjuster, for this additional reason.

Accordingly, withdrawal of this rejection is respectfully requested.

Anticipation Rejection over Phillips et al.

On page 5 of the Office Action, in paragraph 9, claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Phillips et al. (US Patent 5,198,482) and as evidenced by Takagi et al. (US Patent 5,578,420).

In response, Applicants note that Phillips et al. relates to a corrosion-inhibiting coating composition containing, as corrosion inhibitors, amine salts of heterocyclic carboxylic acids. According to the Examiner, Phillips et al. disclose a composition comprising Solvesso 100, which corresponds to the "basically C₉ or C₁₀-based aromatic hydrocarbon(s) having 9 carbon atoms or more within the molecule" in the present invention, and propyleneglycol monomethyl ether and isopropanol, which correspond to the "solvent(s) other than aprotic polar solvents" in the present invention (See Table in column 12, lines 10-15).

Since this composition comprises isopropanol which is one of alcohols, Applicants submit the present invention is distinguished from Phillips et al. by combining claim 3 with claim 15 of the present application, where alcohols are deleted from the group of the other solvent other than aprotic polar solvents recited in claim 15, as mentioned in above.

Also, Applicants note that this composition does not contain a resin, and it was mixed with a Araldite GT 6071 solution containing toluene and n-butanol for preparation of an epoxy primer (column 12, lines 3-7). Therefore, this mixture is different in composition from the remover of the present invention.

Thus, Applicants submit that the present invention is not anticipated by Phillips et al, and withdrawal of this rejection is respectfully requested.

Anticipation Rejection over Van den Berg et al.

On page 6 of the Office Action, in paragraph 10, claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Van den Berg et al. (US Pg-Pub 2002/0123600) and as evidenced by Takagi et al. (US Patent 5,578,420).

In response, Applicants note initially that Van den Berg et al. relates to a coating composition.

According to the Examiner, Van den Berg et al. disclose a formulation comprising Solvesso 100, which corresponds to the "basically C9 or C10-based aromatic hydrocarbon(s) having 9 carbon atoms or more within the molecule" in the present invention, and butyl acetate and EEP (ethoxyethyl propionate), which correspond to the "solvent(s) other than aprotic polar solvents" in the present invention (See Table 1 in paragraph 0064).

However, Applicants submit that the present invention is distinguished from Van den Berg et al. by limiting the content of the aromatic hydrocarbon(s) having 9 carbon atoms or more within the molecule in claim 13 to 10 to 20 percent by mass.

As to newly-added claim 17, Applicants submit that the claimed invention is distinguished from Van den Berg et al. since the claimed remover consists essentially of solvents, while the formulation of Van den Berg et al. contain major amounts of components other than solvents which would have a material effect on the basic and novel characteristics of the present invention as a remover.

Thus, Applicants submit that the present invention is not anticipated by Van den Berg et al., and withdrawal of this rejection is respectfully requested.

Obviousness Rejection over Koyanagi et al in view of Wyatt et al.

On page 7 of the Office Action, in paragraph 12, claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyanagi et al. (WO 03/072634, wherein the citations are from the English equivalent document US Pg-Pub 2005/0153530), in view of Wyatt et al. (US Pg-Pub 2003/0118946).

In response, Applicants submit that Koyanagi et al. relate to a photosensitive resin composition, and disclose tetramethylbenzene having 10 carbon atoms as one of specific examples of a developer (paragraph 0123). Wyatt et al. disclose a developing solution comprising diisopropylbenzene having 12 carbon atoms as an essential component.

However, neither Koyanagi et al. nor Wyatt et al. disclose that tetramethylbenzene has the same developing properties as diisopropylbenzene. Therefore, Applicants submit that one of ordinary skill in the art would not have been motivated to combine Koyanagi et al. and Wyatt et al. Applicants cannot accept the Examiner's position that it would have been obvious to use tetramethylbenzene in an amount of 20% by mass in a solvent mixture used as developer for photosensitive resin of Koyanagi et al., as taught by Wyatt et al.

Further, the present invention relates to a remover, not a developer. Applicants submit that a developer of a resist is different in solubility of a resist from a remover of a resist. Thus, Applicants cannot accept the Examiner's position that the composition of the remover of the present invention would have been obvious by combining prior art relating to a developer.

Thus, Applicants submit that the present invention is not obvious over Koyanagi et al in view of Wyatt et al, and withdrawal of this rejection is respectfully requested.

Obviousness Rejection over Phillips et al.

On page 9 of the Office Action, in paragraph 13, claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (US Patent 5,198,482).

In response, Applicants note that Phillips et al. comprises isopropanol in the composition, as mentioned above. Therefore, Applicants submit that this rejection is overcome by combining claim 3 with claim 15 of the present application, where alcohols are deleted from the group of the other solvent other than aprotic polar solvents recited in claim 15.

In addition, Applicants have add new claim 18 depending on claim 6, which has a limitation that the other solvent other than aprotic polar solvents other than propylene glycol monomethyl ether is at least one selected from the group consisting of propylene glycol monomethyl ether acetate, cyclohexanone, methyl 3-methoxypropionate and ethyl 3-ethoxypropionate (Applicants note that this group corresponds to one obtained by deleting propylene glycol monomethyl ether from the other solvents other than aprotic polar solvents recited in claim 16). Applicants submit that this claim is additionally not obvious as a result of the presence of this further requirement.

Thus, Applicants submit that the present invention is not obvious over Phillips et al., and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/582,787

Attorney Docket No. Q79148

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

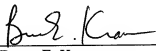
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